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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
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EXAMINER

DICUS, TAMRA

ART UNIT

PAPER NUMBER

1774

DATE MAILED: 10/28/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/981,885

Applicant(s)

HAINES, ROBERT B.

Examiner

Tamra L. Dicus

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 6-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-5 are drawn to a sheet, classified in class 428, subclass 195.
 - II. Claims 6-14 are drawn to a method for marking a sheet, classified in class 101, subclass 2.
 - III. Claims 15-22 are drawn to computer readable medium, classified in class 235, subclass 375.
 - IV. Claims 23-30 are drawn to a device, classified in class D14, subclass 300.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the sheet of Group I can be made by another process such as using more than one action to mark a sheet.
3. Inventions of Groups I and III are independent inventions, one not requiring the particulars of the other. The computer-readable medium of Group III is not required in the sheet of Group I.
4. Inventions of Groups II and IV are independent inventions, one not requiring the particulars of the other. The memory of Group III is not required in the sheet of Group I.

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5. Inventions II and III are independent inventions, one not requiring the particulars of the other. The computer-readable medium of Group III is not required in the method of Group II.

6. Inventions II and IV are independent inventions, one not requiring the particulars of the other. The computer device of Group IV is not required in the method of Group II.

7. Inventions III and IV are independent inventions, one not requiring the particulars of the other. The computer-readable medium of Group III is not required in the method of Group IV.

8. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

9. During a telephone conversation with James McDaniel on 10/23/02 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-5. Affirmation of this election must be made by applicant in replying to this Office action. Claims 6-30 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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11. Claims 1-2 and 4 is rejected under 35 U.S.C. 102(b) as being anticipated by USPN 3,632,995 to Wilson.

Wilson teaches a sheet (coded article) comprising a top, bottom, left, and right facial portions and edges, a single respective fluid-based marking such as ink being positioned on at least one (each) facial portion and edge, where the single fluid-based marking comprises data detectable by an imaging device such as a computer scanner from the at least one facial portion or edge to configure operations such as scanning to form images such as numerals or symbols on the sheet see Figure 1, col. 4, line 17-24, lines 53-70, and col. 8, lines 4-15.

With respect to the limitation “to configure operations to form images...” is not given patentable weight because it has been held that a recitation with respect to the manner in which a claimed product is intended to be employed does not differentiate the claimed product from a prior art product satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ 2d 1647.

12. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by USPN 5,984,193 to Uhling.

Uhling teaches a sheet (paper) comprising a top, bottom, left, and right facial portions and edges, a single respective fluid-based marking such as ink being positioned on at least one (and/or each) facial portion and edge, where the single fluid-based marking comprises data detectable by an imaging device such as a computer printer from the at least one facial portion or edge to configure operations such as reading bar codes to form images such as patterns of code printed on media see Figures 2 & 4, col. 1, lines 45-50, col. 2, lines 20-60. See further col. 4, lines 24-43.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,984,193 to Uhling to USPN 6,037,042 to Kato et al.

Uhling essentially teaches the claimed invention as stated above, but does not teach a plurality of sheets. Kato teaches a label sheet that carries ink and may be in the form of bar codes and perforated into separate sheets in a stacked fashion, see Figure 6, and col. 1, line 27, and col. 5, lines 60-65. Hence it would have been obvious to one of ordinary skill in the art to modify the sheet of Uhling to provide a stack of print media for the purpose of providing sheets that may be separated from each other as taught by Kato at col. 6, line 61.

The examiner has established a *prima facie* case of obviousness and has provided evidentiary support thereof for the rejection under 35 U.S.C. 103(a).

CONCLUSION

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. USPN 6,199,765 to Uhling teaches a sheet of paper formatted to go through a printer. USPN 6,283,031 to Kakuta et al. teaches a sheet such as a plate for use with ink printing.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is (703) 305-3809. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-8329 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Tamra L. Dicus
Examiner
Art Unit 1774
October 24, 2002

CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

